



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/706,683	11/06/2000	Wayne E. Childers JR.	AM100151 01	8281

7590 11/16/2001

Joseph M. Mazzaresse
American Home Products Corporation
5 Giralda Farms
Madison, NJ 07940

EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 11/16/2001

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/706,683

Applicant(s)

CHILDERS et al.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/6/01
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 26-30 is/are pending in the application.
- 4a) Of the above, claim(s) 5, 6, 13 and 16 (in part) is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16, and 26-30 is/are rejected.
- 7) ☒ Claim(s) 4, 7-12, 14, and 15 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1624

In view of applicants' response of 9/6/01 the following still applies.

Applicant's election without traverse of I in Paper No. 8 is acknowledged.

The examiner also stated that treating stroke would be examined which includes claims 26-30. Note that nonelected subject matter still remains in claim 16. Claims 26-30 depend on cancelled claim 25.

Newly amended claims 5,6 and 13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: As clarified by applicants said species are not directed to final products but rather are various intermediates. Said compounds are variously classified in class 544- for claims 5 and 13 in subclass 391 and for claim 6 in subclass 403. These subclasses have not been searched as they are not the field of search required for adamantyl final products. They would be expected to raise different issues of patentability. At the very least compound of claim 6 would be an obvious precursor to compounds distinct from that claimed herein as suggested by Abou-Gharbia (US'814), col.3, which is of record.

Since applicant has received an action on the merits for the originally presented (elected) invention, this invention has been constructively elected by

Art Unit: 1624

original presentation for prosecution on the merits. Accordingly, claims 5,6 and 13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claims 1,2,16,26-30 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The how to make and use rejections remain for these claims. The only comment made with regard to these rejections is that claim 1 has been amended but the scope recited is as broad as originally described in the specification vs the working examples (which have been searched) which are representative of claim 3 as previously stated.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Abou-Gharbia in view of Cliffe. Note that claim 16 is no longer rejected since the **elected** use, the sole use examined is not taught in these references. Upon review of the secondary reference claims limited to Y-R1 as benzyl, i.e where $m=1$

Art Unit: 1624

are not particularly suggested as there is no exemplification of this sidechain when X is NR₄COR₆ in Cliffe or in remaining other derivatives. However subject matter where m=0 remains obvious. It is not agreed that all species in the primary reference differs by more than one respect. Note again 2nd species in col.3 which has an ethylene link just as required herein. The secondary reference is not believed to be dissimilar with the primary since it also deals with N-piperazinyl amides that permit a cycloalkyl of up to 12 carbons on the acyl carbon. See eg.37 in Cliffe as an example of such where the sidechain is a phenyl group. By their very name, secondary references are expected to have some structural differences from what is instantly claimed otherwise they would be primary references or anticipations. Also they have common uses if not the same use as elected herein. The test for obviousness is not whether the elements of one reference can be bodily incorporated into the invention of another but rather what the combined teachings of the references would have suggested to those of ordinary skill in the art. Note In re Wood 202 USPQ 171. Thus there is sufficient motivation to employ phenyl in place of hydrogen in the closest compound of Abou- Gharbia and its preparation well within ordinary skill of the art as urged by applicants in their own

Art Unit: 1624

specification and suggested in the reaction of scheme I in col.5 of US'552. Note US'552 teaches the adamantyl acyl chloride is available and this when coupled with the amine of eg.37 in US'278 would give an instant product.

Claims 4,7-12¹⁴⁻¹⁵ are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

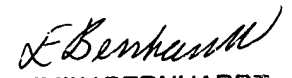
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1624

Any inquiry concerning this communication should be directed to Emily Bernhardt at telephone number (703) 308-4714.

A facsimile center has been established for Group 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703) 308-4556 or (703) 305-3592.


EMILY BERNHARDT
PRIMARY EXAMINER